

ATTORNEY'S DOCKET NO: 0492611-0392 (MIT 9128)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anderson et al. Examiner: Baker
Serial No.: 09/803,319 Art Unit: 1639
Filed: March 9, 2001
For: USES AND METHODS OF MAKING MICROARRAYS OF
POLYMERIC BIOMATERIALS

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. §1.116

Responsive to the Final Office Action mailed May 7, 2003 and further to the Interview held with Examiner Baker on August 14, 2003, Applicant respectfully requests entrance of the following Amendment and consideration of the following Remarks. A Request for Continued Examination is enclosed. The deadline for responding to the Final Office Action was August 7, 2003. A Petition for a one (1) month extension of time up to and including September 7, 2003 is enclosed. Applicant submits that the present Response is therefore timely filed on August 18, 2003.

Please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this Response.

Remarks begin on page 10 of this Response.

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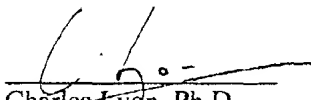
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that are commonly administered as pharmaceuticals. The term "combinatorial compounds" has been replaced with "a compound that belongs to a synthetic combinatorial library of compounds" in claim 58 (e.g., see claim 53 and page 13, lines 6-9 for support). Applicant respectfully requests that the indefiniteness rejection of claim 12 be withdrawn in light of this amendment.

Finally, the rejection of claims 1-6, 8-12 and 14-20 under 35 U.S.C. §112, first paragraph for lack of written description was discussed. The Examiner indicated that in this regard her greatest concern was with the terms "polymeric biomaterial". The Examiner further indicated that the claim amendments that had been proposed to overcome the 102(b) rejection would go some way towards alleviating her concern. After a brief discussion of the methods that Applicant has used to prepare various microarrays, Applicant suggested further amending claims 1 and 2 to specify that the polymeric biomaterials include a *soluble* synthetic polymer. The Examiner agreed that such an amendment was well supported by the specification (e.g., see page 2, lines 28-22; page 8, line 28 to page 9, line 1; page 12, lines 1-7; and page 14, line 23 to page 15, line 8) and that it would further move prosecution of this case in the right direction.

Based on the arguments presented above, it is submitted that the pending claims, as amended herein, are allowable over the art of record. Applicant would again like to thank the Examiner for granting a telephone interview and for her thoughtful comments and careful consideration of the case. If a further telephone conversation would help expedite prosecution of this case, please do not hesitate to contact the undersigned at (617) 248-4793. Additionally, please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully submitted,



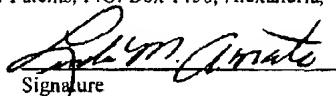
Charles Lyon, Ph.D.

Agent for Applicant

Limited Recognition Under 37 CFR §10.9(b)

CHOATE, HALL & STEWART
Exchange Place
53 State Street
Boston, MA 02109
(617) 248-5000

Dated: August 18, 2003
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